

## **REMARKS**

This paper is filed in response to the Office Action dated October 28, 2003. Because this paper is filed on March 1, 2004 and is accompanied by a request for a one-month extension of time, this paper is timely filed.

### **I. Status of Amendments**

Claims 1-44 were pending prior to this amendment. By this amendment, applicant cancels claims 1-44 without prejudice to refile, and adds new claims 45-88. Thus, claims 45-88 are now pending.

Because applicant previously paid fees for 4 independent and 44 total claims, applicant's amendments do not require a further fee to be paid.

### **II. Response to Office Action**

#### **A. General Comments**

Although the application describes various embodiments and makes various statements regarding the "invention," it is well settled that the legal scope of the invention is defined by the words of the claims and that it is improper to read features of the embodiments described in the specification into the claims. It should also be recognized that the term "invention" may be used to mean various different things.<sup>1</sup> For example, the term "invention" may be used to refer to the technical subject matter that has been invented; the term "invention" may be used to refer to subject matter which is nonobvious; and the term "invention" may be used to refer to subject matter defined by the claims of a patent. Thus, the mere fact that the present application uses the term "invention" in various statements does not mean that the scope of the claims is limited by such statements.

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<sup>1</sup> This is explained in the Glossary of Volume 1 of Chisum on Patents, where the term "invention" is defined as follows:

INVENTION – In patent law, the word 'invention' has several different meanings. It may refer to (1) the act of invention through original conception and reduction to practice; (2) subject matter described and/or claimed in a patent, patent application or prior art reference (e.g., a product or process); or (3) the patentability requirement of invention, first developed by the courts and now subsumed in the statutory requirement of nonobviousness. Thus, an applicant may have invented (1) an invention (2) which is unpatentable for lack of invention (3) because it is an obvious modification of an invention (2) used by others in this country before the invention (1) thereof by the applicant.

It should also be understood that, unless a term is expressly defined in the application using the sentence “As used herein, the term ‘\_\_\_\_\_’ is hereby defined to mean...” or a similar sentence, there is no intent to limit the meaning of that term, either expressly or by implication, beyond its plain or ordinary meaning, and such term should not be interpreted to be limited in scope based on any statement made in any section of the present application (other than the language of the claims). Finally, unless a claim element is defined by recital of the word “means” and a function without the recital of any structure, it is not intended that the scope of any claim element be interpreted based on the application of 35 U.S.C. § 112, sixth paragraph.

It is respectfully submitted that the foregoing comments regarding claim construction are consistent with 35 U.S.C. §112 and the Office practice of utilizing the “broadest reasonable interpretation” of claims.

It is also respectfully submitted that the claims are supported by the application, that the claims satisfy the written description requirement and the other requirements of 35 U.S.C. §112, and that no new matter is being added. In this regard, it is well settled that the specification need not reproduce the exact language of the claims to satisfy the written description requirement of §112, first paragraph. In re Wright, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989) (“[T]he claimed subject matter need not be described in haec verba in the specification in order for that specification to satisfy the description requirement.”). The written description requirement of §112 can even be satisfied based solely on the drawings of a patent application. Vas-Cath Inc. v. Mahurkar, 19 U.S.P.Q.2d 1111, 1118 (Fed. Cir. 1991) (“These cases support our holding that, under proper circumstances, drawings alone may provide a ‘written description’ of an invention as required by §112”).

**B. The October 28 Office Action**

In the October 28 Office Action, the title was objected to as allegedly non-descriptive. Applicant has deleted the old title, and presents a new title herewith. It is believed that the objection has been traversed.

Additionally, claims 1-6, 8-12, 14-20, 22-25, 30-35 and 44 were rejected under 35 U.S.C 102(b) as allegedly anticipated by Kojima (UK Published Application No. GB 2,316,214), claims 7, 26-29 and 36-43 were rejected under 35 U.S.C. 103 as allegedly unpatentable over Kojima in view of Falciglia (U.S. Patent No. 5,971,849), and claims 13 and 21 were rejected under 35 U.S.C. 103 as allegedly unpatentable over Kojima in view of Bridgeman (U.S. Patent No. 5,046,736). As applicant has cancelled claims 1-44 without

prejudice to refile, the rejections are moot. However, in light of the reliance on Kojima, applicant has the following comments.

At page 4, Kojima states:

Thus, a first payline, for example the centre row, can be generated. Next, a bet can be accepted and a pattern generated on a single additional display. The new display will form at least one new payline. Adding another display will form even more paylines so that the number of paylines added with each additional display increases as the number of bets are made.

It will be noted from the passage that Kojima states that all of the symbols along at least the first payline are displayed before the player is permitted to make a selection of a further display which will define further paylines. In fact, Kojima consistently states that all of the symbols along a first payline will be displayed before the player is given an opportunity to select a further payline in those instances where some of the symbols are displayed before a player selects all of his or her paylines. It is submitted that there is no clear disclosure, teaching or suggestion in Kojima that fewer than all of the symbols along the first payline will be displayed before the player is permitted to select other paylines.

By contrast, claim 45 recites a gaming method for an apparatus including a plurality of reels, each of the reels having a plurality of positions associated therewith in which indicia may be displayed, and a plurality of pay lines, each pay line including one position from each the reels. The method includes receiving a wager, displaying indicia in the positions associated with a first group of the plurality of reels, the first group defined as fewer than all of the plurality of reels, receiving a selection of at least one pay line after the indicia in the positions associated with the group of the plurality of reels is displayed, displaying indicia in the positions associated with a second group of reels, the second group defined as those reels not in the first group, and determining a payout according to the at least one pay line selected.

In particular, it will be noted that claim 45 recites that each pay line includes one position from each of the reels and that the first group of reels includes fewer than all of the plurality of reels. Moreover, a selection of at least one pay line is received after the indicia in the positions associated with the first group of reels is displayed. Thus, according to the claimed method, the selection of the pay line occurs before all of the indicia are displayed along any of the pay lines.

Thus, comparing with the passage cited above and the statements of Kojima taken as a whole, Kojima simply does not disclose each and every element of the claimed subject matter of claim 45. Moreover, Kojima consistently states that no selection occurs until after all of the symbols along a first payline are shown. Thus, Kojima actually teaches away from

the claimed subject matter. Moreover, it is submitted that the strategies to be used by the player differ significantly when all of the symbols along a payline are displayed before the player selects a payline than when all of the paylines are incomplete.

Given that Kojima does not disclose, teach or suggest each and every limitation of the claimed subject matter, claim 45 is allowable. Moreover, given that Kojima does not anticipate or render obvious claim 45, claims 46-54, which depend from claim 45, are also allowable.

Moreover, it is applicant's position that the arguments raised above relative to claim 45 apply with equal force to claims 55, 62, and 79. That is, in keeping with the arguments advanced above, Kojima also does not anticipate or render obvious claims 55, 62, and 79. Further, given that claims 55, 62 and 79 are not anticipated or rendered obvious, claims 56-61, 63-78 and 80-88 that depend from claims 55, 62 and 79, respectively, also are allowable.

#### **Other Issues**

The undersigned notes that the October 28 Office Action was mailed to the law firm of Trask Britt in Salt Lake City, Utah. However, the responsibility for the prosecution of this application has been transferred from the Trask Britt firm to Marshall Gerstein & Borun LLP in Chicago, Illinois. The attorneys of Marshall Gerstein & Borun LLP filed a Power of Attorney and Revocation of Prior Powers (with Certification under 37 C.F.R. 3.73(b)) on September 13, 2002. A return receipt postcard was mailed with the Power and Revocation of Prior Powers, and an entry was made in the docket for this case that, in keeping with the normal and established practices of Marshall, Gerstein & Borun LLP, would indicate that we received the return receipt postcard from the United States Patent and Trademark Office ("USPTO"). We have been unable, however, to locate this return receipt postcard. At any rate, we submit copies of the previously submitted papers herewith, and request that the USPTO accept the Power of Attorney and Revocation of Prior Powers and change the mailing address for this application.

Additionally, applicant submits herewith a Supplemental Information Disclosure Statement and accompanying PTO-1449 form.

In summary, in view of the foregoing, it is respectfully submitted that the above application is in condition for allowance, and reconsideration is respectfully requested. If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact

the undersigned representative at the telephone number set forth below. Further, if there are any additional fees or refunds required, the Commissioner is directed to charge or debit Deposit Account No. 13-2855.

Respectfully submitted for,

MARSHALL, GERSTEIN & BORUN LLP

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By: Marla L. Hudson  
Marla L. Hudson  
Registration No. 43,680  
6300 Sears Tower  
233 South Wacker Drive  
Chicago, Illinois 60606-6357  
(312) 474-6300  
(312) 474-0448 (fax)